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PERKINS COIE LLP P.O. BOX 2168 MENLO PARK, CA 94026			EXAMINER CHANG, KENT WU	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/328,053
Filing Date: June 08, 1999
Appellant(s): FLACK ET AL.

Yenyun Fu

For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 2/20/08 appealing from the Office action
mailed 7/2/07

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,602,566	MOTOSYUKU et al.	2-1997
5,686,942	BALL	11-1997
6,009,210	KANG	12-1999
6,178,403	DETLEF	01-2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-3, 6-16, 19-32, 34-45, 47-50, 52-55, 58-68, 71-83, 86-96, 99 are rejected under 35 U.S.C. 103(a) as being unpatentable over Motosyuku et al (US 5,602,566) in view of Ball (US 5,686,942).

Motosyuku et al discloses a hand-held computer having a digital processor, a motion sensor (104) for tracking movements of the display, mapping visual information generated by the computer into a virtual desktop suitable for display via the display device, displaying a certain portion of the virtual desktop via the display device, and adjusting the displayed information according to the movements of the display.

Although Motosyuku does not clearly point out that the computer maps the entire information content to the virtual desktop to allow the user accessing the entire information content, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Motosyuku to map the entire information content to the virtual desktop so as to enable the user to access the entire information content via the input system since the purpose of scrolling is to allow the user to access information content that is not being displayed. In fact, the scroll function of Motosyuku's input device is to allow a user to access the portion/segment of the information content that are not being displayed due to the limited display space of the screen. Motosyuku controls the scrolling based on the rotational movement of the display device instead of a translational movement.

However, Ball teaches a system to generate input data to a computer comprising a camera housing in the display device, and generate input data to control the scroll function based on the translational movement of the display relative to a reference target (note that the translational movement of the display relative to the reference target is equivalent to the translational movement of the reference target relative to the display). Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to use a camera housing in the display device, and generate input data to control a display based on the translational movement of the display relative to a reference target as taught by Ball in the device of Motosyuku so as to provide simple and intuitive method to enter control data to the computer.

Furthermore, the device of Motosyuku as modified by ball could have been used to run any type of application including the display and navigation of a physical map (as recited in claims 32 and 83), a real scene in real space and time, panning and zooming functions since Ball suggests to use the device to run different applications and uses the input data to move images or position objects (column 1 lines 12-22). The examiner takes Official Notice that it has been well known in the art to use coordinate input data of the input device (mouse, joystick, trackball, etc.) to control the scrolling, zooming, and navigation in a display.

Motosyuku does not show a second computer. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the coordinate input data to control any computer since it merely depends on the hardware configuration of the system.

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5. Claims 4, 5, 33, 56, 57, 84, 85 are rejected under 35 U.S.C. 103(a) as being unpatentable over Motosyuku et al (U.S. Patent No. 5,602,566) in view of Ball (US 5,686,942) as applied to claims 1, 33 above, and further in view of Kang (US 6,009,210).

Motosyuku as modified does not expressly teach to control movement of the displayed image without moving the display device, i.e., moving the image based on lingering deviation from the reference target.

However, in the same field of endeavor, Kang teaches moving the image based on lingering deviation from the reference target so as to provide a device with simple and easy operation (column 8 lines 26-49). Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the device of Motosyuku to enable moving the image based on lingering deviation from the reference target as taught by Kang so as to provide a device with simple and easy operation as suggested by Kang.

6. Claims 17, 18, 46, 51, 69, 70, 97, and 98 are rejected under 35 U.S.C. 103(a) as being unpatentable over Motosyuku et al (U.S. Patent No. 5,602,566) in view of Ball (US 5,686,942) as applied to claims 1, 16, 45, 68, 96 above, and further in view of Detlef (U.S. Patent No. 6,178,403).

Motosyuku as modified does not show handwriting recognition capability and voice recognition capability.

However, Detlef teaches a PDA having handwriting recognition capability and voice recognition capability for user entering data to the computer (column 1 lines 24-

40). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include handwriting recognition capability and voice recognition capability as taught by Detlef in the device of Motosyuku so as to enable the user to enter data to the computer without a keyboard as suggested by Detlef.

(10) Response to Argument

Appellant mainly argues that the combination of Motosyuku and Ball fail to teaches three limitation elements (see page 12 in the Appeal Brief):

1) mapping the information content generated by the computer system into a virtual desktop suitable for conveying the information content to the user, 2) tracking the translational movement of the display device, and 3) adjusting the displayed certain portion of the virtual desktop in a manner related to the tracked movements of the display device by which the user is able to traverse the entire information content mapped to the virtual desktop and examine any certain portion or segment of the information content using the computer system's display device.

In response to the argument pertaining to element 1, note that it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Motosyuku to map the entire information content to the virtual desktop so as to enable the user to access the **entire information content** via the input system since the purpose of scrolling is to allow the user to access information content that is not being displayed. In fact, the scroll function of Motosyuku's input device is to allow a user to access the portion/segment of the information content that are not being displayed due to the limited display space of the screen.

In response to the argument pertaining to elements 2 and 3, note that

A. Motosyuku teaches controlling the scroll function based on the **movement of a display device**, and Ball teaches controlling the scroll function based on the **translational movement** of the input device, wherein using translational movement as taught by Ball to replace the rotational movement in the device of Motosyuku would have provided the user an alternative method in controlling the scroll function in a simple and intuitive way. Therefore, the combination of Motosyuku and Ball meets all of the limitations as claimed. Appellant's arguments against the references individually are unpersuasive since one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

B. incorporating the teaching of Ball to build a camera in the computer system of Motosyuku would have led to a portable computer capable of controlling the scroll function by 1). the translational movement of the portable computer relative to a stationary object (such as the nose of the user), or 2). the translational movement of an object (such as user's nose) relative to a stationary portable computer. Moving the portable computer **or/and** the object (such as the user's nose) by the user would perform equally well in controlling the scrolling of the display and the selection of which method would be merely at the user's discretion.

In response to appellant's argument that Motosyuku and Ball fail to teach the limitation of "transforming visual information generated by the physical map application

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into a virtual map suitable for display via the display device”, note that the device of Motosyuku as modified by ball could have been used to run any type of application including the display and navigation of a map application (as recited in claims 32 and 83), a real scene in real space and time, panning and zooming functions since Ball suggests to use the device to run different applications and uses the input data to move images or position objects (column 1 lines 12-22).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner’s answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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